

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

REMARKS/ARGUMENTS

In the March 2, 2005 Office Action, the Examiner objected to the drawings, rejected the claim as indefinite, and rejected the claim as anticipated by U.S. Patents Nos. 6,257,538 to Pangborn *et al.* and 6,270,047 to Hudson. The Applicant respectfully traverses the Examiner's objection and rejections and submits that the claimed subject matter is allowable and solicits an indication of allowability at an early date.

Support for the New Claim

The Applicant respectfully submits that the above-identified application adequately supports new claim 2. Among support for new claim 2 is Figure 1 which illustrates an embodiment of the claimed subject matter having a mounting member, a first link member, and a second link member. Figure 2 shows the distal bracket (which is substantially not seen in Figure 1). Figure 1 shows an auxiliary shelf support. In this art, one of ordinary skill would know that a substantially flat auxiliary shelf is mounted on such a shelf support. An embodiment of the rotating member is shown in Figure 24.

The Drawings

In the March 2, 2005 Office Action, the Examiner objected to the drawings because they did not include the reference sign "bar 310". On review of the above-identified application, it is apparent that bar 310 (of paragraph 0043) is the structure – *i.e.*, the bar – also labeled 160. Bar 160 is described in paragraph 0045. For instance, paragraph 0043 states that "knob 120 is mounted on bar 310." Whereas paragraph 0045 states that "Bar 160 runs from

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

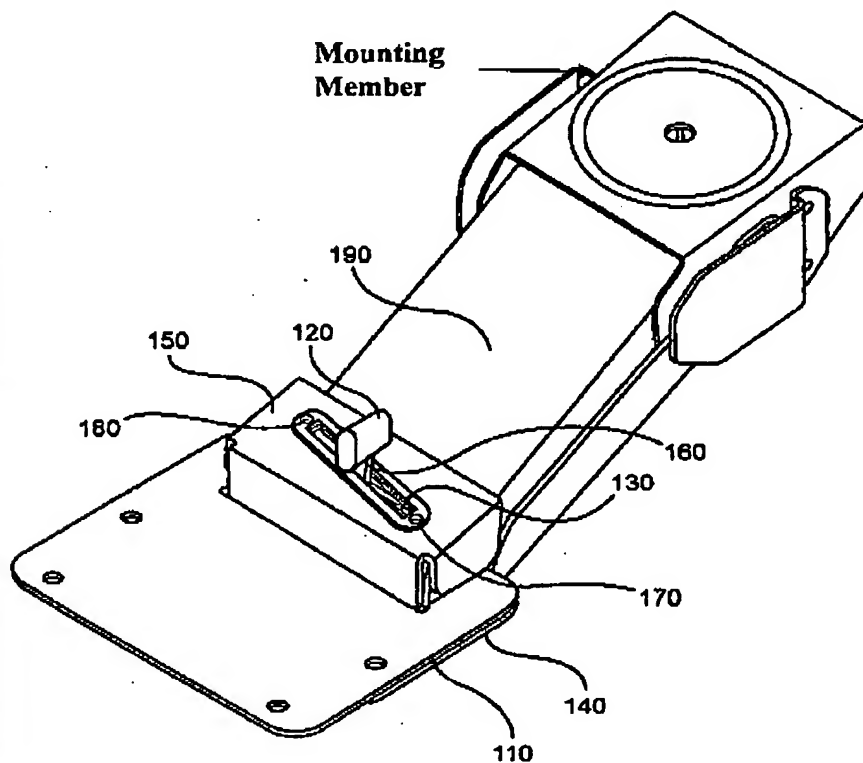
know 120” In view of the redundancy of the label 310, the Applicant amended the specification of the above-identified application by replacing the text “310” in paragraph 0043 with reference numeral 160. Furthermore, the Applicant respectfully submits that this amendment obviates the basis for the Examiner’s objection to the drawings and respectfully requests that the Examiner withdraw this objection.

The Examiner also objected to the drawings because they allegedly “fail to show ‘auxiliary support mechanism’, ‘a mounting member’, ‘a second elongated slot’, ‘an acute angle with respect to the substantially parallel slot’, and ‘a spring means mounted on the third member in a manner effective to urge the third member into an upward position’. The Applicant respectfully traverses this objection.

The Examiner alleges that the drawings of the above-identified application fail to show an “auxiliary support mechanism”. The Applicant respectfully traverses the Examiner’s objection and submits that Figure 1 shows an ‘auxiliary support mechanism’. In particular, the Applicant notes that paragraph 39 states “[t]urning to FIG. 1, the adjustable support mechanism 100”. Thus the above-identified application illustrates an ‘auxiliary support mechanism’.

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

The Examiner also alleges that the drawings of the above-identified application fail to show 'a mounting member'. The Applicant respectfully traverses the Examiner's submits that one of ordinary skill would recognize the structure in Fig. 1 attached to the end of structure bearing point 190 away from box member 150 to be a mounting member. See also the Applicant's earlier U.S. Patent No. 5,924,664 for further elucidation of what those of ordinary skill understood the term "mounting member" to mean in the context of an adjustable support mechanism.



Patent Application Publication Nov. 18, 2004 Sheet 1 of 16 US 2004/0227044 A1

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

The Examiner further alleges that the drawings of the above-identified application fail to show "second elongated slot". The Applicant again traverses the Examiner's objection and respectfully submits that the drawings show a second elongated slot. For instance, Fig. 15 clearly shows "slot 1030". Slot 1030 is in box member 150, which is an embodiment of the second member of claim 1. Fig. 17 illustrates a first member as recited in claim 1 with its first elongated slot 1710. Thus, the drawings do illustrate the "second elongated slot".

The Examiner additionally alleges that the drawings of the above-identified application fail to show "an acute angle with respect to the substantially parallel slot". Once more, the Applicant respectfully traverses the Examiner's objection and submits that this structure is apparent in the drawings to one of ordinary skill.

In responding to this objection, the Applicant notes that "An acute angle is one which is less than 90°". <http://www.mathsisfun.com/acute.html> viewed on June 22, 2005. Additionally, the Applicant notes that the "acute angle" in question is formed by the overlap of the first and second elongated slots. With this understanding, it is clear that this "acute angle" can be seen in Fig. 3. In this view from the top, through slot 130 (the second elongated slot in this embodiment) one can see a portion of the first elongated slot (which is not labeled). Thus, the drawings illustrate this feature of the claimed subject matter.

The Examiner still further alleges that the drawings of the above-identified application fail to show "a spring means mounted on the third member in a manner effective to urge the third member into an upward position". Again, the Applicant respectfully traverses the Examiner's objection and submits that this structure is apparent in the drawings to one of ordinary skill. In particular, the Applicant notes that paragraph 0046 expressly states that "[a]lso

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

shown in FIG. 3 is a **spring member 330** which generally urges the support platform assembly into a preset neutral position." (Emphasis added). In sum, the drawings illustrate the features recited in the pending claims.

Because (a) the Applicant corrected the use of two reference numerals in the text for a single structural element; and (b) each structural detail that is essential for a proper understanding of the claimed subject matter is shown in at least one drawing, the Applicant respectfully requests that the Examiner withdraw the pending objection to the drawings under 37 C.F.R. §§ 1.83(a) and 1.84(p)(5).

The Indefiniteness Rejection

The Examiner rejected the claim as indefinite because the Examiner could not find sufficient antecedent basis for the terms "the end" in lines 2 and 12 and "the mounting member" in lines 3 and 13. The Applicant respectfully traverses the Examiner's position and submits that there is a sufficient antecedent basis for each of these terms.

The examination of patent claims for compliance with 35 U.S.C. § 112, ¶ 2 is guided by the Manual of Patent Examining Procedure ("MPEP"). The current edition is the eighth (2001). Section 2173.05(e) *Lack of Antecedent Basis* states:

Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. *If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid"). (Emphasis added).

Particularly pertinent to the issue raised by the Examiner, the MPEP continues by stating:

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

Inherent components of elements recited have antecedent basis in the recitation of the components themselves. For example, the limitation "the outer surface of said sphere" would not require an antecedent recitation that the sphere has an outer surface. *See Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001) (holding that recitation of "an ellipse" provided antecedent basis for "an ellipse having a major diameter" because "[t]here can be no dispute that mathematically an inherent characteristic of an ellipse is a major diameter").

Thus the issues raised by the Examiner's indefiniteness rejection are:

- 1) Is a "mounting member [an inherent component] of the auxiliary support mechanism"? and
- 2) Is an "end of an auxiliary support mechanism distal to the mounting member" and inherent component of the auxiliary support mechanism?

The Applicant respectfully submits that both the mounting member and the end are inherent components of the auxiliary support mechanism. Consequently, there is sufficient antecedent basis in the claim as written.

Moreover, the Applicant notes that it is the Examiner's burden to make a *prima facie* showing before making a rejection. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (The examiner bears the initial burden on any ground of presenting a *prima facie* case of unpatentability.) Here, the Examiner has not shown that either (a) the mounting member, or (b) the end, are not inherent components of the auxiliary support mechanism. Thus, the Examiner has not made a *prima facie* showing of indefiniteness. In the absence of a *prima facie* showing of indefiniteness, the rejection must be withdrawn.

The Anticipation Rejections

The Examiner rejected the claim as anticipated by U.S. Patents Nos. 6,257,538 to Pangborn *et al.* and 6,270,047 to Hudson. For the following reasons, the Applicant respectfully

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

traverses the Examiner's findings and submit that the claimed subject matter is not anticipated by either of the cited references.

U.S. Patent No. 6,257,538 to Pangborn et al.

The Examiner alleges that the Pangborn patent discloses the claimed subject matter. The Applicant respectfully submits that the Examiner has misconstrued the claimed subject matter and thus has not made a *prima facie* showing that Pangborn anticipates the claimed subject matter. For this reason alone, the present rejection must be withdrawn.

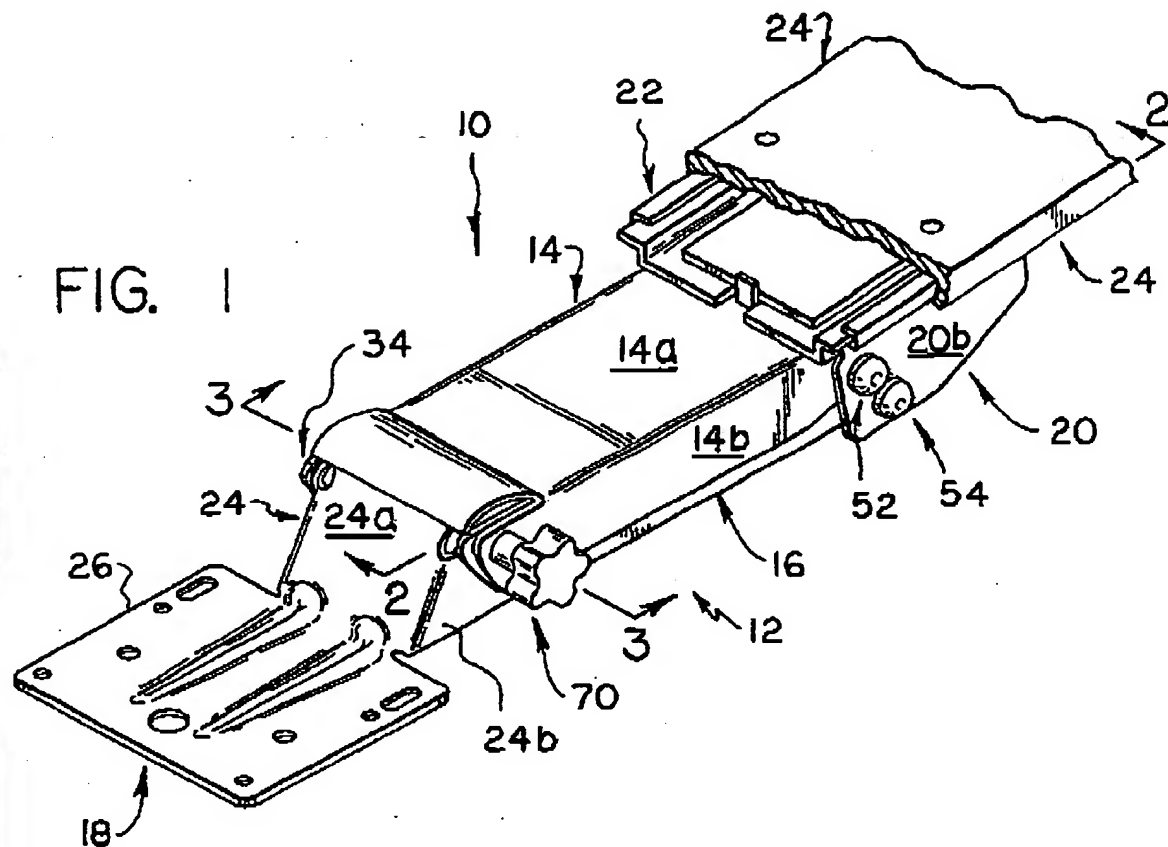
The Examiner alleges that "Pangborn et al. teaches an auxiliary shelf adjustment mechanism comprising: a first member (20, 24) having a plurality of surfaces mounted on an end of an auxiliary support mechanism distal to the mounting member of the auxiliary support mechanism," Office Action at 5. While this assertion's use of the terms of the claim might be consistent with some undefined dictionary, it is inconsistent with the above-identified application. For this reason, the Applicant respectfully submits that the Examiner's construction of the claim is not reasonable.

When the claim is read on the preferred embodiments given in the above-identified application, it is apparent that the mounting member is that portion of the auxiliary support member that connects to the primary support, e.g., desk or other table.

Thus, we turn to examine the Pangborn patent to ascertain what part, or parts, connect Pangborn's auxiliary support mechanism to a primary support. From Fig. 1 of Pangborn, it is obvious that the mounting member of Pangborn's auxiliary support mechanism is the structure labeled 20. The text of Pangborn, e.g., "second or rear ends pivotally connected to a second element 20, which is adapted for mounting on a suitable base, such as may be defined

Appl. No.: 10/737,040
 Amtd. dated 06/22/2005
 Reply to Office action of March 2, 2005

by the top of a table or work station"¹ confirms that element 20 corresponds to the mounting member of the claim.



Because Pangborn element 20 is the mounting member, element 20 cannot be distal to the mounting member. Thus, the Examiner has not made a *prima facie* showing that Pangborn discloses the claimed subject matter. For this reason, the present rejection must be withdrawn.

¹ Col. 2, lns. 3-5.

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

U.S. Patent No. 6,270,047 to Hudson

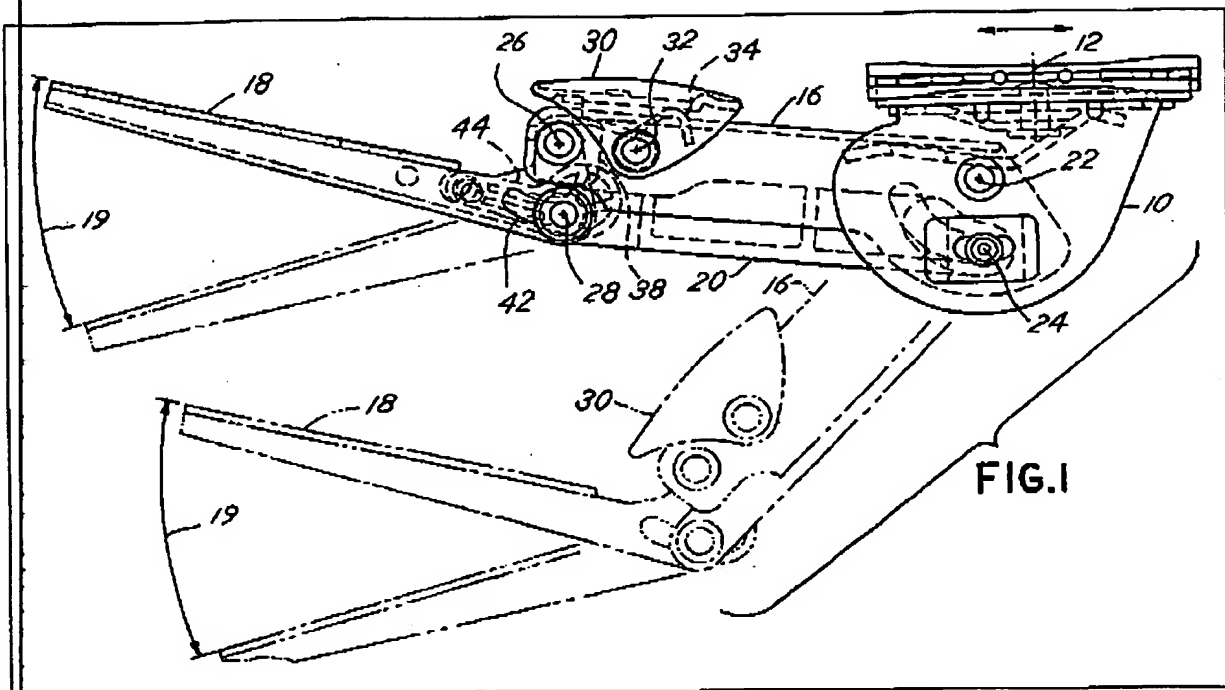
The Examiner alleges that the Hudson patent discloses the claimed subject matter.

The Applicant respectfully submits that the Examiner has misconstrued the claimed subject matter and thus has not made a *prima facie* showing that Hudson anticipates the claimed subject matter. For this reason alone, the present rejection must be withdrawn.

The Examiner alleges that "Hudson teaches an auxiliary shelf adjustment mechanism comprising: a first member (10) having a plurality of surfaces mounted on an end of an auxiliary support mechanism distal to the mounting member . . . : Office Action at 6. An implicit premise in the Examiner's assertion is that first member (10) is not the mounting member.

However, a review of the Hudson patent establishes that this premise is false. Specifically, as shown in Fig. 1 of Hudson, first member (10) is the member that connects the auxiliary shelf mechanism to the main surface, *i.e.*, first member (10) is the mounting member. Hudson confirms this analysis of Fig. 1 by stating: "slide bracket assembly 10 which is slidably mounted in a bracket (not shown) that is mounted to the underside of a work surface, desk or platform," Col. 2, lns. 51 – 54.

Appl. No.: 10/737,040
 Amdt. dated 06/22/2005
 Reply to Office action of March 2, 2005



Because Hudson's first member 10 is the mounting member, first member 10 cannot be distal to the mounting member. Thus, the Examiner has not made a *prima facie* showing that Hudson discloses the claimed subject matter. For this reason, the present rejection must be withdrawn.

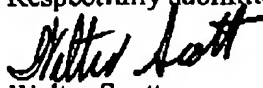
The Applicant respectfully petitions for a one month extensions of time to reply to the March 2, 2005 Office Action. The Applicant submits that no further extension of time nor fees for net addition of claims are required. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned

Appl. No.: 10/737,040
Amdt. dated 06/22/2005
Reply to Office action of March 2, 2005

under 37 CFR §1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Dated: June 22, 2005

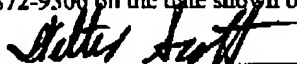
Respectfully submitted,


Walter Scott
Registration No. 30,588

Customer No. 00826
ALSTON & BIRD LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
Tel New York (212) 210-9518
Fax Charlotte Office (704) 444-1111

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the US Patent and Trademark Office at Fax No. (703) 872-9306 on the date shown below.



June 22, 2005
Date